

## **REMARKS**

In view of the above amendments and following remarks, reconsideration of the rejections that are contained in the Office Action of July 10, 2008 is respectfully requested.

### **Interview With Examiner Graybill**

The Examiner is thanked for his courtesy in granting and conducting the interview with the undersigned. During that interview, changes to independent claims 27 and 44 were proposed. The Examiner had no comment with respect to these changes. No agreement was reached during the interview. The following discussion reflects Applicants' arguments during the interview.

### **Drawing Objections**

On page 2 of the Office Action, the Examiner objected to the drawings as not showing every feature of the invention that is specified in the claims under 37 CFR 1.83(a). This objection is traversed on two bases. First, it is acknowledged that Rule 83 requires the drawing in an application to show every feature of the invention that is specified in the claims. However, what the Examiner is requiring to be illustrated is a characteristic of the respective adhesive holding regions that does not readily admit of illustration. MPEP §608.02(d) states that "any structural detail that is of sufficient importance to be described should be shown in the drawing" (emphasis added). The tackiness between the first adhesive holding region and the main body, and the tackiness between the second adhesive holding region and the main body, being larger than the first tackiness and the second tackiness, as claimed, refers to the tackiness of the respective regions, which is a characteristic of the regions, and is not a structural feature.

Secondly, to the extent appropriate, the feature is in fact illustrated. Note Figs. 6 and 7. Pallet 1a including first adhesive holding region 21 and second adhesive holding region 22 is used to hold an FPC 9 as shown in Fig. 6. The first adhesive holding region 21 holds the peripheral portion of the FPC 9 with a relatively low tackiness and the second adhesive holding region 22 holds the central portion of the FPC 9 with a higher tackiness than that of the first adhesive holding region 21. The use of, for example, blown air makes it possible to peel to the FPC 9 off of the pallet 1a. As

discussed in paragraph 10 on page 6 of the original specification, the upper face of the pallet 1a has an adhesive holding layer 12 formed thereon. The adhesive holding layer 12 constitutes a holding surface 121 on which the FPC is held through adhesion. The holding surface 121 of the holding layer 12 includes the first adhesive holding region 21 and second adhesive holding region 22 as further described in paragraph 10. As shown by Fig. 7, the FPC 9 is removed while the adhesive holding layer 12 remains on the pallet 1a. As such, the tackiness between the first adhesive holding region 21 and the planar base plate 11 of the pallet 1a, and the tackiness between the second adhesive holding region 22 and the planar base plate 11, are larger than the tackiness of the first and second adhesive holding regions 21 and 22 with the FPC 9. This is illustrated in Fig. 7 by the fact that the adhesive holding layer 12 remains on the pallet 1a upon separation of the FPC 9. Thus, the feature which the Examiner alleges is not illustrated is in fact illustrated.

With respect to the Examiner's objection to the presence of reference number 1 in the abstract, this reference number has been deleted.

With respect to the Examiner's objection to reference number 708 throughout the specification, this reference number has been previously changed. The Examiner is respectfully requested to confirm that the substitute specification of July 10, 2006 has been entered into the application to effect this change.

The Examiner next identifies reference number 12 in paragraph 15, Fig. 3. However, there is no reference number 12 in paragraph 15 describing Fig. 3. It is noted that reference number 12 is used in the specification to refer to adhesive holding layer illustrated, for example, in Fig. 2.

The Examiner's objection to Figs. 1-5, 14-16 and 18 as not including required lead lines is acknowledged. These lead lines have now been included.

Regarding the Examiner's drawing objections on page 4, the Examiner's objection relating to Figs. 1, 10, 18 have been corrected in the drawings.

Regarding reference characters 12 and 21 of Fig. 2, the Examiner's objection is traversed. In Fig. 2, reference character 12 is directed to the adhesive holding layer, as described in the specification. Reference character 121, shown at a different location, goes to the same part because

it indicates the surface (the holding surface) of the adhesive holding layer 12. Thus, they are not per se the same part.

Regarding Figs. 6 and 7, reference characters 551 and 552 are not directed toward the same part. As can be clearly seen in both drawing figures, reference character 551 is directed toward a structural feature at the lower part of the drawing, and reference character 552 is directed toward a structural feature at the upper part of the drawing. These structural features are the retention mechanism 551 at the lower part and the pickup mechanism 552 at the upper part. Thus, they are not the same part, and they are not used to designate the same part, as is clear from the drawings and the specification.

Turning to Fig. 17, reference characters 121 and 1c are not used to designate the same part. 1c designates the pallet, and is positioned on the right hand side of the drawing figure, and reference character 121 is used to designate the surface of the holding layer. Thus, they do not point to the same particular aspect or part. This is also clear from the description. The same is true for reference characters 121 and 1e of Fig. 19, and reference characters 121 and 1f of Fig. 21.

The Examiner further objected to Fig. 16 because reference character 91 was used to designate different parts. However, this is not the case. Reference character 91 is used to designate the same part repeated at six different positions. This is acceptable practice.

### **Objections to the Disclosure Based Upon Informalities**

The Examiner objects to paragraph 6 because of a confusing disclosure. However, the portion quoted by the Examiner appears to be present in paragraph 3 of the substitute specification, not paragraph 6. This portion has been reworded to try to make it less confusing to the Examiner.

The Examiner objects to the language "mirror face", "1S" and "1.6S" as being unclear. However, this position by the Examiner is respectfully traversed. These terms are understood by one of ordinary skill in the art as being indicators of surface coarseness.

The point made by the Examiner with respect to paragraph 67 is, to some degree, acknowledged, and the paragraph has been rephrased above.

### **Objection to Disclosure Under 35 U.S.C. §132(a) as Introducing New Matter**

The Examiner objects to the amendment to paragraph 31 as introducing new matter. The Examiner's position is incorrect.

The addition to paragraph 31 states that the tackiness between the first adhesive holding region and the planar base plate 11, which serves as the main body, as well as the tackiness between the second adhesive holding region and the main body, are larger than the tackiness of both the first and second adhesive holding regions 21 and 22. Thus, it is clear from this statement that what is being said is that the tackiness of the adhesive holding layer, including the first and second adhesive holding regions, with the main body, which is the planar base plate 11, must be greater than the tackiness of the first and second adhesive holding regions 21 and 22 that are used for holding the FPC 9. As discussed above, this must of course be the case, because the adhesive holding layer remains on the pallet when the FPC 9 is removed. This is clear from the drawing figures and the description, as has been previously discussed.

On page 18 of the Office Action, the Examiner responds to Applicants' prior arguments regarding this point as stating that Applicants' conclusion is ambiguous because it is not clear whether the language "this feature" and "how this happens" refers to the feature of the tackiness with respect to the first and second adhesive holding regions or the feature of "that upon separation of the FPC 9, which had been held in the adhesive holding layer 12, the FPC 9 is peeled off and the adhesive holding layer 12 remains on the main body of the pallet 1a." However, the Examiner's distinction is irrelevant. The point is the same. The meaning of the two phrases is the same.

The Examiner states that the Examiner does not object to the discussion regarding the separation of the FPC 9 or the drawings. This is also irrelevant. The point is that the drawings illustrate that the adhesive remains on the pallet when the FPC 9 is separated. This is the same thing that is being said in paragraph 31 of the specification and in the claims.

The Examiner then goes on to state that the disclosure of Fig. 7 does not necessarily illustrate what has been added to paragraph 31. However, this is incorrect. This is in fact what it directly illustrates. It can be clearly seen from the drawing figure that when the FPC 9 is peeled off, the adhesive holding layer 12 remains on the main body of the pallet 1a. The Examiner appears to make

this point by stating that "in fact, as elucidated infra, there is alternative disclosure showing how, allegedly, upon separation of the FPC 9, which had been held on the adhesive holding layer 12, the FPC 9 is peeled off and the adhesive holding layer 12 remains on the main body of the pallet 1a." Thus, it appears that the Examiner is conceding the point that the adhesive holding layer, which includes the first and second adhesive holding regions, remains on the pallet 1a when the FPC 9 is separated. Thus, it appears that the Examiner and Applicants are not in basic disagreement with about what happens here; the adhesive remains on the pallet when the FPC 9 is peeled off. This is shown in the drawings and clear from the specification. This is, essentially, all that Applicants are attempting to state. Accordingly, as will be further discussed below, an alternative way of stating this is now presented in both the specification and in claim 51.

At the bottom of page 19 of the Office Action, the Examiner quotes Applicants' arguments, and traverses the argument stating that "because the alleged disclosure that adhesive holding regions 21, 22 remain on the pallet 1a during the process of peeling off of the FPC 9 does not inherently mean that the tackiness between the main body and the adhesive holding regions is greater than the first and second tackiness of such regions." However, this is what it means.

The Examiner clarifies by referring to the discussion of tackiness in the specification and the assumption that the force that is required to peel off the pallet 1a from the adhesive holding regions is greater than the force required to peel off the FPC 9 from the adhesive holding regions 21 and 22, but that there is no disclosure that the force that is required to peel off the pallet 1a from the adhesive holding regions is greater than the force that is required to peel off the FPC 9 from the adhesive holding regions and that the "certain conditions" under which such peeling happens are identical. However, this is not the case. The discussion of how the FPC 9 is peeled off illustrates how force is applied, for example, by pins against the FPC 9 to push it off of the adhesive holding regions. If the tackiness between these regions and the main body were smaller than that for the FPC 9, they would clearly remain with the FPC 9, and not the main body. However, as is clear from the specification, this is not the case. Thus, under the conditions this must in fact happen. The Examiner's discussion of the various conditions in which the FPC 9 may be pulled off do not contradict this fact. Nor does the fact that the FPC 9 and the pallet 1a could be of different materials.

### **Rejections Under 35 U.S.C. §112, Second Paragraph**

The Examiner's rejection of claims 27-30, 32, 38-40 and 42-44 as being indefinite is traversed. The Examiner considers the limitation directed to the tackiness between the first adhesive holding region and the main body and the tackiness between the second adhesive holding region and the main body being larger than the first tackiness and the second tackiness to be unclear because the measure of the property of tackiness is not disclosed, is indeterminable, units of measurement are not disclosed and it is unclear if the property is intensive or extensive. However, these alleged points of unclarity are not relevant to the issue. Tackiness is defined in the specification sufficiently for one of ordinary skill in the art to understand the simple point that the adhesive holding regions adhere to the main body more strongly than the first and second adhesive holding regions would adhere to the circuit board, for example. This is a relative measure and easily understood by one of ordinary skill in the art. Further, the point of 112, second paragraph is to ensure that one of ordinary skill in the art understands the scope of the claim language so that they can determine whether or not the language is infringed. This is readily determinable as seen from this discussion.

### **Objection Under 37 CFR 1.75(c)**

Claims 28 and 29 were objected to by the Examiner as failing to further limit the subject matter of a previous claim. This position is respectfully traversed.

Claim 28 specifies that the first and second adhesive holding regions are on a surface of adhesive material provided on the main body. This specific location of the adhesive holding regions was not set forth in claim 27, and thus the claim further limits claim 27.

Claim 29 further limits claim 28 further specifies that the adhesive holding region is within one area of the adhesive material that is on the main body.

Claims 27 and 44 are not substantial duplicates. The preamble of claim 44 is directed to a pallet for carrying a circuit board, whereas the preamble of claim 27 is directed to a substrate holder for holding a circuit board. The scope of coverage could thus be different.

### **Rejections Under 35 U.S.C. §112, First Paragraph**

The Examiner further rejects the claims as failing to comply with the written description requirement for the tackiness limitation discussed above. However, as has been previously discussed, this aspect is inherent in the specification and drawings of this application. It is clear to one of ordinary skill in the art in looking at the specification that the limitation is an aspect of the invention. This becomes especially clear when looking at the description of the function of the invention in which the pallet or substrate holder is reused, whereby necessity the adhesive remains on the main body during repeated instances of holding a substrate.

### **Rejections Based on Prior Art**

The Examiner rejected claims 27-30, 32, 38-40 and 42-44 as being unpatentable over Kuhns, U.S. Patent Publication 2004/0119593, Nishikawa, JP 7074497 and Sher, U.S. Patent 6,197,397. However, all of the claims pending in this application clearly distinguish over this prior art.

It is initially noted that independent claims 27 and 44 have been amended to further recite that the second adhesive holding region is surrounded by the first adhesive holding region. This aspect was previously recited in dependent claim 38, for example, using slightly different language. It is also readily seen from Fig. 1, for example.

This feature is also present in new independent claim 45. Independent claim 45 corresponds largely to prior claim 27, but specifically recites an adhesive holding layer as comprising a first adhesive holding region and a second adhesive holding region. Further, it also does not include the recitation of the tackiness between the first and second adhesive holding regions and the main body being larger than the first tackiness and the second tackiness, avoiding a number of the Examiner's other objections and rejections. All of these claims, along with their dependent claims, clearly define over the references that have been cited by the Examiner.

Kuhns does not disclose the first adhesive holding region surrounding the second adhesive holding region. The Examiner cites a first adhesive holding region 19a and a second adhesive holding region 19b. However, as can be seen from Fig. 2, for example, the adhesive holding region 19a is present on opposite sides, but does not surround, adhesive holding region 19b. Thus, Kuhns

cannot meet this limitation. For this reason, all of the independent claims define over the rejections that have been cited by the Examiner.

It is noted that Nishikawa was cited by the Examiner as having a through hole 4 for receiving a pin 5 for peeling off of a circuit board 2. The Examiner considered this obvious to combine with Kuhns in order to facilitate the release of the liner of Kuhns. This combination, however, makes no sense.

Kuhns is directed to a tamper-indicating radio frequency identification antenna in the form of a sticker that is attached to equipment. The point of Kuhns is to provide an arrangement in which if the radio frequency identification device (RFID) is attempted to be removed, the antenna will be destroyed. In particular, note the discussion in paragraph 56 on page 7 of Kuhns. The point of having two different strength adhesives 19a and 19b is to change the amount of pull that is necessary to increase the pulling to a sharper radius and more likely causes fracture 28 to occur in metal powder layer 12 as shown in Fig. 4b. Kuhns does not desire to assist in any removal.

Thus, Nishikawa and Kuhns are not analogous prior art. They are not in the same field, they do not address the same problems, and they have absolutely no reason why one of ordinary skill in the art would look to combine one with the other. There is no logical reason why one of skill in the art would combine these two.

The combination of Sher with Kuhns also is a pure hindsight reconstruction that has no logical reason in the prior art for supporting the combination.

None of these references, further, teaches the second adhesive holding region being surrounded by the first adhesive holding region. Even if there were a liner to be removed from the adhesive surface of Kuhns prior to application, for example, such would not require a through hole for receiving a pin for removal of any such liner. Nishikawa is directed to problems that are directed to the present invention, but have no application whatsoever to Kuhns, and the combination is not logical.

The dependent claims further define over the prior art references. The Examiner's attention is particularly directed to new dependent claim 51, which presents a slightly different statement of the fact that the adhesive adheres to the main body when a circuit board is separated from the first and



second adhesive holding regions. This is supported by the original specification for the same reasons as have been previously discussed. The language is slightly different, and presented to more directly state the point. Supporting language has been provided in the specification in paragraph 31. This does not constitute the introduction of new matter, as the support for this language is inherent in the original specification and drawings.

### **Response to the Examiner's Various Arguments**

The Examiner has presented a number of separate rationales for supporting the various positions regarding the prior art. Firstly, it is noted that the above further distinctions in each of the independent claims clearly define over all of the prior art, and it may not be necessary at this point to address all of the Examiner's positions. However, some of these positions may be addressed at this point, and Applicants reserve their right to address any such further positions as may be necessary in any later submission.

The Examiner takes the position that first and second adhesive holding regions 19a and 19b of Kuhns inherently corresponds to first surface coarseness and second surface coarseness. However, there is nothing to indicate from the prior art that the surface portions of these regions would be different. Applicants specifically indicate that their adhesive can be of the same material, and in the independent claims recite that the surface coarsenesses are different and correspond to different tackinesses. This is not necessarily the case with the prior art, however, despite the position of the Examiner. It is not inherent that the surface coarsenesses of the regions are different, as a different level of tackiness could be achieved in different ways. The Examiner takes the position that it would have been "obvious to try" using the same adhesive material. Note page 12 of the final Office Action. The Examiner cites the obviousness to try a standard as recently articulated in the KSR decision. However, this applies only in a situation where there is an identified problem with a finite number of identified and predictable solutions. There is no evidence that this is the case in the present situation. There could be millions of different types of adhesives that could be used, and there is nothing to suggest using the same material for two different tackiness strengths in Kuhns. Thus, the obvious to try standard does not apply. The same is true for the Examiner's discussion on

page 13, continuing to page 14, of the Office Action. The same is also true for the Examiner's discussion on pages 16 and 17 of the Office Action.

### **Conclusion**

Taken in its entirety, the Examiner's rejections are readily seen as being incorrect, improper and against currently legal standards. The various rejections raised by the Examiner must thus be withdrawn.

In view of the above amendments and remarks, it is submitted that the present application is now in condition for allowance, and the Examiner is requested to pass the case to issue. If the Examiner should have any comments or suggestions to help speed the prosecution of this application, the Examiner is requested to contact Applicants' undersigned representative.

Respectfully submitted,

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